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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,800	06/30/2000	Chandrasekhar Narayanaswami	13576 (YOR9-2000-0226)	1158

7590 08/06/2003

Richard L Catania  
Scully Scoot Murphy & Presser  
400 Garden City Plaza  
Garden City, NY 11530

EXAMINER
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TRAN, HENRY N

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 08/06/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/607,800

Applicant(s)

NARAYANASWAMI,  
CHANDRASEKHAR

Examiner

HENRY N. TRAN

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 May 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-11 and 14-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-27 is/are allowed.
- 6) ☒ Claim(s) 1,3-11,14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 17 June 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

### DETAILED ACTION

This Office action is in response to the applicant's amendment received 5/20/03 (paper no. 9). The amendments to the specification and the claims have been entered; and applicant's remarks were considered, with the results set forth as following.

Claims 1, 3-11 and 14-27 are pending in this application.

#### *Specification*

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The examiner is unable to find the proper antecedent basis for the claimed limitations: "a control mechanism", and "a mechanism for interfacing with a second computing device" recited in lines 7 and 10 of claim 1 because they are not appearing in the specification. Applicant's arguments provided in pages 11 and 12 of the amendment are insufficient for having clear support for said limitations because it is not proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claim. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *Internet America Inc. v. Kee-Vet Lab. Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989). Therefore, it would not be proper for the examiner to give words of the claim special meaning when no such special meaning have been defined by the applicant in the written description.

Art Unit: 2674

The applicant is required to provide an amendment to the specification for providing written descriptions to explicitly and clearly including special definitions set forth for said above claimed limitations.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 3-15 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 3-15 recite the claimed limitations: “a control mechanism”, and “a mechanism for interfacing with a second computing device” in lines 7 and 10 of claim 1, which are not described in the specification. The examiner has read the claim in light of the specification. However, the examiner is unable to find a clear support for said claimed limitations. It is necessary to define what “a control mechanism” and “a mechanism for interfacing with a second computing device” are in order to insure certainty in construing the claims in light of the specification (see references recited above, also, MPEP 608.01 (o)).

Art Unit: 2674

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1 and 3-15 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 3-15 recite the claimed limitations: "a control mechanism", and "a mechanism for interfacing with a second computing device" in lines 7 and 10 of claim. There are insufficient antecedent basis for these limitations in the claims. The examiner is unable to find special definitions set forth for said claimed limitations in the claims and/or the specification.

***Allowable Subject Matter***

6. Claims 16 to 27 are allowed.
7. The following is an examiner's statement of reasons for allowance:

The present invention comprises an apparatus and a method for customizing software applications for receiving, storing, transferring, and altering user preferences and user application via a mouse device as specifically defined in the independent claims 16 and 22. The closest prior art, Allport (US 6,256,019) shows a similar device 10 (a controller 10) which also stored personalized user preferences. However, Allport fails to: receiving personalized data from the first computing device, storing said personalized data in a memory provided in said mouse, subsequently transferring said stored personalized data to a like user application executing in a

Art Unit: 2674

second computing device, and altering said like user application. These distinct features have been specifically defined in the independent claims 16 and 22; and render them allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1 and 3-27 have been considered with the results as follows:

The amendment to the claims have overcome the objections and rejections defined in items 4, 7-9, and 12-20 recited in the prior Office action. However, claims 1 and 3-15 stand rejected under 35 U.S.C. 112, first and second paragraphs, as specifically discussed above.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2674

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENRY N. TRAN whose telephone number is (703) 308-8410. The examiner can normally be reached on Mon - Fri from 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD A. HJERPE, can be reached at (703) 305-4709.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

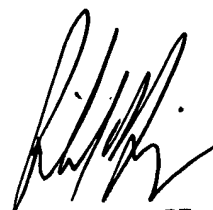
**(703) 872-9314 (for technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office Whose telephone number is (703) 306-0377.

HENRY N. TRAN *HT*  
Examiner  
Art Unit 2674

hnt  
July 27, 2003

  
RICHARD HJERPE  
SUPERVISOR, ARTS/EXAMINER  
TECHNOLOGY CENTER 2600